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10/027,658	12/20/2001	James Michael Shumpert	384.7509USU	1146

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EXAMINER

NGUYEN, TAN D

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3689

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/027,658	Applicant(s) SHUMPERT, JAMES MICHAEL	
	Examiner Tan Dean D. Nguyen	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/09 has been entered.

Claim Status

2. Claims 1-6, 8-9, 10, 12-15 and 17-18 are pending. Claims 7, 11 and 16 have been canceled. The claims comprise:

1) Method: 1-6, 8-9, and

2) System: 10, 12-15 and 17-18,

System claim 10 will be examined first.

As of 2/12/09, Independent system claim 10 is as followed:

10. (currently amended) A computer system for determining authenticity of a business partner in response to a request of a user comprising:

a) a device for receiving a request ~~of a user to determine~~ that indicates that a user desires a determination of an authenticity of a business partner; and

b) at least one processor for performing the steps of:

(i) receiving an identity of said business partner from said user;

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(ii) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having at least one data attribute that matches said identity;

(iii) if said matching finds a match, then:

(iv) determining whether said business partner is authentic by processing at least one of said data attribute of the matched said business data record with at least one business according to a set of authentication rules ~~to determine if said business partner is authentic~~, wherein said data attribute represents at least one credential of said business partner; and

(v) if said matching fails to find a match, then:

(vi) presenting a registration template to said business partner for registration in said business database; and

(vii) updating said business database with registration data; and

c) a notifying means for notifying said user of the ~~determination made by said processor~~ whether said business partner is authentic.

Note: for convenience, letters (a)-(c) are added to the beginning of each element.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1, 3-6, 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-6, 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Here claims 1, 3-6 and 8-9 fail to meet the above requirements since there is not a sufficient tie to another particular machine or apparatus nor transform underlying subject matter (such as an article or materials) to a different state or thing. The

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preamble includes the term "A computer-implemented method" is noted but the preamble is normally being considered as "capable of" or "optional".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 10, 12-15, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by KORITZINSKY ET AL.

Claim 10 basically reads: a computer system [for determining authenticity of a business partner in response to a request of a user] comprising:

a) a device [for receiving a request ~~of a user to determine~~ that indicates that a user desires a determination of an authenticity of a business partner]; and

b) at least one processor [for performing the steps of:

- (i) receiving an identity of said business partner from said user;
- (ii) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having at least one data attribute that matches said identity;
- (iii) if said matching finds a match, then:
 - (iv) determining whether said business partner is authentic by processing at least one of said data attribute of the matched said business data record with at least one business according to a set of authentication rules ~~to determine if said business partner is authentic~~, wherein said data attribute represents at least one credential of said business partner; and
 - (v) if said matching fails to find a match, then:
 - (vi) presenting a registration template to said business partner for registration in said business database; and
 - (vii) updating said business database with registration data]; and
- c) a notifying means for notifying said user of the ~~determination made by said processor~~ whether said business partner is authentic.

9. Note: that independent claim 10 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure

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rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “for determininga user” carries no patentable weight. The bracket “[...]” above indicated that this limitation has no patentable weight.

Similarly, KORITZINSKY ET AL discloses:

a computer system;

{see Figs. 1, 4, 6}

a) a device

{see Figs. 1, 4 and 6} and

c) a notifying means for notifying said user [of the ~~determination made by said processor~~ whether said business partner is authentic].

{see Figs. 1, 4, 6, 15 and 16 (element 440)}.

As for dep. claims 12-14 (part of 10 above), which deal with means for providing a form, document or template, these are taught on Figs. 6-8.

As for dep. claims 15 and 18 (part of 10 above), they have no apparatus structures and therefore having no patentable weight in an apparatus as indicated above. Moreover, these are inherently included in the system of KORITZINSKY ET AL as shown on Figs. 6-8, 15-16.

As for dep. claim 17 (part of 10 above), which deals with means for searching or querying a database, this is taught in Figs. 15 or 16 or 12 and 1-2.

Claim Rejections - 35 USC § 103

10. Claims 1-6, 8-9 (method), 10, 12-15, 17-18 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant's Admitted Prior Art (AAPA) in view of (2) ROSS or vice versa and further in view of (3) KORITZINSKY ET AL.

As for independent claims 1 and 10, AAPA, as cited on page 1, line 8 to page 2, line 14 (or US 2003/0120614, paragraphs [0003]-[0004]) fairly teaches current method for determining authenticity of a business partner in response to a request of a user in an off-line or manual technique by entering the request of a user into a computer system associated with the business database, the authentication process then employs a matching technique to find a data record of a business in the business database that matches the identifying data of the business partner. The data record of the matched business is then assessed for authenticity. The request also provides some data that identifies the business partner {see page 1, lines 30-31 "*Current methods Use an off-line technique...*"}. AAPA fairly teaches the claimed invention

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except for carrying out using a computer or “computer-implemented” as shown in the preamble and carrying out step (d) according to a set of authentication rules.

In a similar method for verification of user authentication, **ROSS** fairly teaches a computer-implemented method for a subject or data remote authentication submitted by a remote user to determine whether the subject/data is authenticate (or verification of requested subject /data or **user authentication**) and according to a set of authentication rules (d) {see [0004], [0008], [0014], [0025][0026], Fig. 1. The term “subject” refers to any person or entity being authenticated. User authentication is the process of determining whether the subject is who he claims to be. Note that ROSS also discloses the carrying out the steps online in the case of Web forms {see [0004], and [0008]}. It would have been obvious to modify the teachings of AAPA of “subject (person) authentication” to include computer-implemented and authentication rules as taught by ROSS to obtain well known benefits of the online process (remote uses or anywhere) and convenience such as quick response.

Vice versa, the teachings of ROSS is cited above. It would have been obvious to modify the subject/person request from a client/user of ROSS wherein the subject/data is about an authenticity of a business partner as taught by AAPA as mere applying the same authentication/verification techniques to other type of subject/data or requested subject/data from the user or wherein the function or intended use of the subject/data is for authentication of a business partner.

The teachings of AAPA/ROSS fails to disclose the step of wherein said matching fails to find a match, then... and updating the database with registration data.

KORITZINSKY et al is cited to teach a method/system for verifying a service such as subscription or status checking by carrying out similar steps as indicated above and specifically the step of "wherein said matching fails to find a match, then... and updating the database with registration data" to insure the service is not interrupted {see Figs. 15, 16, cols. 12,13, 21-23. It would have been obvious to modify the teachings of ROSS /AAPA to include the teaching of KORITZINSKY et al to insure the service is maintained or not expired.

As for dep. claim 2 (part of 1 above) which deals with automation parameters, this is taught in ROSS [0008] or KORITZINSKY et al Figs. 1 or 2. Note that the automation step is well known step and is taught in GUSTAFSON col. 2, lines 50-55, or would have been obvious to a skilled artisan to do so to improve efficiency. See *In re Venner*, 120 USPQ 192, CCPA 1958.

As for dep. claims 3-5 (part of 1 above) which deals with well known computer data entry parameters, i.e. standard template for entry of data or filling out a form, this is taught in ROSS [0008].

As for dep. claim 6 (part of 1 above) which deals with well known authentication rules parameter, i.e. types of rules such as current transactions with trade reference, etc., this is fairly taught in ROSS [0004-0005][0014-0016].

As for dep. claims 8-9 (part of 1 above) which deals with well known matching parameters, i.e. other attributes such as license, professional membership, etc., these are fairly taught in ROSS [0004, 0008, 0014, 0021, 0034], Fig. 2. Moreover, this varies with the type of request, business entity, etc., and the selection of the desired

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information is within the knowledge of the skilled artisan, an experienced businessperson with many years of practical experience. Moreover, this is non-functional descriptive material (information) and generally receives no patentable weight unless there is a step for carrying out a transaction.

As for dependent system claims 12-15, 17-18 (part of 10 above), which have similar limitations as in dep. claims 3-6 and 8-9 (part of 1 above), they are rejected for the same reasons set forth in the rejections of claims 3-6 and 8-9 above.

Response to Arguments

11. Applicant's arguments, see paper filed 2/12/09, with respect to the rejections of claims 1-18 have been fully considered and are not persuasive in view of the new ground rejections which are caused by applicant's amendment of the claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2001/0032092, by Calver, teaches the apparatus claims above and is cited here for applicant's awareness of potential use in the future if needed.

No claims are allowed.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689